

REMARKS**Status of the Claims**

Claim 1 is pending and stands subject to an election of species requirement, addressed below.

Election of Species Requirement

The Examiner asserts that pending claim 1 includes 45 patentably distinct amino acid sequences and has required election of "a single disclosed species combination in each of the F1, F2 and F3 zinc fingers." (Election Requirement, paragraph 1).

Applicants provisionally elect QRSNLVR for F1; QSGNLAR for F2; and QSGNLAR for F3, with traverse, which reads on pending claim 1.

First and foremost, Applicants note that the same election of species requirement has been previously withdrawn by the Office. *See*, Restriction Requirement mailed October 9, 2003; Response mailed November 7, 2003; and paragraph 1 of the Office Action mailed December 19, 2003 withdrawing the election of species requirement. It is both inconsistent and inefficient to reinstate an election requirement that has been overcome.

As before, Applicants traverse on the grounds that it is entirely incorrect and improper to assert that there are 45 distinct species in claim 1. The Patent Office's own rules are clear that an Examiner cannot refuse to examine a single claim in its entirety, unless that claim lacks unity:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention**, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984) Broadly, unity of invention exists where [the species] (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

...In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. M.P.E.P. § 803.02, emphasis added.

In the pending case, Applicants submit that the Office is again improperly refusing to examine that which they regard as their invention. Applicants' claimed invention clearly necessitates the recitation of multiple sequences in a single claim inasmuch as it is drawn to methods of designing zinc finger proteins that recognize a target site of the form GNNGNNGNN. Plainly, Applicants regard their invention as a method of designing a number

of multi-finger proteins, wherein each finger of a multi-finger protein binds to a GNN target subsite, and the amino acid sequence of the finger depends on the nucleotide sequence of the subsite. As such, there is no appropriate generic language that can be used to describe Applicants' method, and it is entirely improper for the Office to parse the pending claim into 45 different species. In sum, given the nature of the pending claim, Applicants submit that the election of species requirement cannot be applied or maintained and, moreover, prevents Applicants from clearly and distinctly claiming their invention.

Furthermore, unity of invention, according to M.P.E.P. § 803.02, is clearly present -- all allegedly distinct "species" share a common utility (binding to GNN triplets) and share a substantial structural feature disclosed as being essential to that utility (a zinc finger comprising a 7 amino acid recognition region that binds to a target triplet).

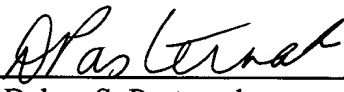
Finally, Applicants also traverse on the grounds that it would not be unduly burdensome to search the allegedly distinct species together. In fact, for the reasons noted above, it is required that multiple sequences be searched together. Additionally, a search for any combination of F1, F2 and F3 zinc finger proteins would necessarily reveal relevant art to each of the allegedly distinct species. It would, therefore, not be burdensome (and even save the Office time and resources) to examine the claim as a whole.

It is to be understood that these elections of species are for the purposes of preliminary search and examination only, and that upon allowance of these species, Applicants will be entitled to consideration of additional species in this application.

In view of the foregoing remarks, Applicants respectfully submit that the election of species requirement be withdrawn. Should the Examiner instead choose to make this election of species requirement FINAL, Applicants reserve their right, pursuant to 37 C.F.R. § 1.144, to petition this requirement at any time during the pendency of this application, prior to appeal.

Respectfully submitted,

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